

REMARKS/ARGUMENTS

The Office is requiring restriction to one of the following groups:

Group I: Claims 1-11, drawn aluminum oxide;

Group II: Claims 12-14, drawn to a method of making aluminum oxide; and

Group III: Claims 15-18, drawn to a method of using aluminum oxide.

Applicants elect, with traverse, Group I, Claims 1-11, for examination.

Restriction is only proper if the claims of the restricted groups are independent or patentably distinct and there would be a serious burden placed on the Office if restriction is not required (MPEP §803). The burden is on the Office to provide reasons and/or examples to support any conclusion in regard to patentable distinction (MPEP §803). Moreover, when citing lack of unity of invention in a national stage application, the Office has the burden of explaining why each group lacks unity with the others (MPEP § 1893.03(d)), i.e. why a single general inventive concept is nonexistent. The lack of a single inventive concept must be specifically described.

The Office alleges that the claims of Groups I-III do not relate to a single general inventive concept under PCT Rule 13.1 because, under PCT Rule 13.2, they lack the same or corresponding special technical features for the following reasons: "U. S. patent No. 6,193,795 discloses a pyrogenic aluminum oxide having a BET of 80-120 m<sup>2</sup>/g and a DBP of 150-200 g/100g. In view of this, the technical feature (i.e. aluminum oxide powder) does not make a contribution over the art and thus utility is lacking and restriction is appropriate."

Annex B of the Administrative Instructions under the PCT, paragraph b (Technical Relationship), states, emphasis added:

The expression "special technical feature" is defined in Rule 13.2 as meaning those technical features that defines a contribution which each of the inventions, *considered as a whole*, makes over the prior art. The determination

is made on the contents of the claims as *interpreted in light of the description* and drawings (if any).

Applicants respectfully submit that the Office did not consider the contribution of each invention, *as a whole*, over the cited reference in alleging the lack of a special technical feature. Applicants also respectfully submit that the Office has not provided any indication that the contents of the claims *interpreted in light of the description* were considered in making this allegation. Furthermore, 37 C.F.R. § 1.475(b) states in part, emphasis added:

(b) An international or a national stage application containing claims to different categories of invention will be considered to have unity of invention if the claims are drawn only to one of the following combinations of categories: ...

(3) A product, a process specially adapted for the manufacture of the said product, and a use of the said product

The Office has divided the claims into the categories of a product, a process of manufacturing the product, and a process of using the product. Therefore, under 37 C.F.R. § 1.475(b), the present claims have unity of invention. Thus, the Office has not met the burden necessary to support the assertion of a lack of unity of the invention.

For the reasons presented above, Applicants submit that the Office has failed to meet the burden necessary in order to sustain the requirement for restriction. Applicants therefore request that the requirement for restriction be withdrawn.

Applicants respectfully submit that the above-identified application is now in condition for examination on the merits, and early notice thereof is earnestly solicited.

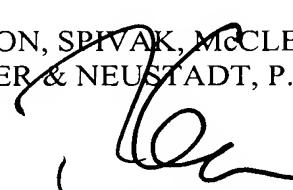
Respectfully Submitted,

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